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| 09/914,454 | 01/14/2002 | Guido Grandi | PP01591.101 | 4170 |
| Alisa A Harbin Chiron Corporation Intellectual Property R-338 P O Box 8097 Emeryville, CA 94662-8097 | | | | |
| 7590 08/21/2009 | | | EXAMINER | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/914,454

Applicant(s)

GRANDI ET AL.

Examiner

N. M. Minnifield

Art Unit

1645

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6, 8-21, 23, 24, 32-39 and 43-48 is/are pending in the application.
- 4a) Of the above claim(s) 32-39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6, 8-21, 23, 24 and 43-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 32-39 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/3508)
Paper No(s)/Mail Date 5/27/09
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 27, 2009 has been entered.
2. Claims 1-4, 6, 8-21, 23, 24 and 43-48 have been examined in the instant application. It is noted that a new ground of rejection has been set forth.
3. This application contains claims 32-39 have been drawn to an invention nonelected with traverse in the paper filed January 24, 2005. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.
4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
5. Claims 1-4, 6, 8-21, 23, 24 and 43-48 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for an immunogenic composition comprising an immunostimulating amount of Neisseria antigen and an immunostimulating amount of an adjuvant (SEQ ID NO: 1 and an emulsion comprising submicron oil droplets and emulsifying agent (CFA)), does not reasonably provide enablement for immunogenic composition comprising an immunostimulating amount of Neisseria antigen and an immunostimulating amount of an adjuvant (oligonucleotide comprising at least one CG motif and an emulsion comprising submicron oil droplets and emulsifying agent). The specification does not enable

any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

The claims recite "an oligonucleotide comprising at least one CG motif". The claims do not define the size of the oligonucleotide and only define two of the nucleotides, CG. The claims do not define whether the "at least one CG motif" is methylated or unmethylated.

The state of the art with regard to the CpG oligonucleotides and stimulating a Th-1 immune response is unpredictable. The state of the art teaches that there are a number of specific characteristics of the oligonucleotide, which are critical for its function as an immunostimulatory molecule. For instance, Krieg (BioDrugs 1998, 5:341-346) teaches that synthetic oligonucleotides ranging in length from 8 to 30 nucleotides or more could cause immune stimulation if there was only a single CpG dinucleotide as long as this was not preceded by a C or followed by a G. Most importantly, the CpG dinucleotide had to be unmethylated: if the C was replaced by s-methyl-cytosine, then the oligonucleotide lost its immune stimulatory activity (p. 342). The pending claims neither recite that the C or G is unmethylated nor the length of the oligonucleotide. Yamamoto et al 1994 (Antisense Research and Development, 1994, 4:119-122) teaches that "immunostimulatory activity of oligonucleotides 18 bases or more in length was observed and was proportional to the base length, with a maximum at 22-30 bases. On the other hand, the oligonucleotides 16 bases or less in length were not as active even if they possessed the palindromic sequences. These results indicate that the immunostimulatory activity of oligonucleotides with certain palindromic sequences requires an oligonucleotide at least 18 bases long." (abstract). Agrawal et al. (Trends in Mol. Med., 2002; 8:114-121) teaches that the pattern and kinetics of induction of the cytokines in vivo depends on the sequences flanking the CpG dinucleotide, as well as the dose, the route of administration and the host animal species (see page 16 "therapeutic potential of CpG DNA" in particular) and that there is a species-dependent selectivity of CpG DNA, and that the optimal CpG DNA sequences for many vertebrate species are not yet known (p. 119). Further, Agrawal et al. teach that "The presence of unmethylated CpG dinucleotide is essential for the induction of immunostimulatory activity..." (See p. 114, bottom of second column). Agrawal also teaches that sequences required for CpG related immune stimulation varies from species to species, and indicates, "The optimal motif for recognition by human immune cells is 'GTCGTT or TTCGTT' (p. 115). Thus indicating that an

oligonucleotide of 6 nucleotides in length can function as an immunostimulatory agent in humans. Hartmann et al. (*J. Immunology*, 2000; 164:1617-1624) teaches that the oligonucleotide must be protected from nuclease degradation in order to be effective in vivo. Specifically, Hartmann teaches, "To have in vivo clinical utility, ODN must be administered in a form that protects them against nuclease degradation. The native phosphodiester internucleotide linkage can be modified to become highly nuclease resistant via replacement of one of the non-bridging oxygen atoms with a sulfur, which constitutes phosphorothioate ODN." (see p. 1618). Therefore, in order for an oligonucleotide to stimulate an immune response in vivo it must contain an unmethylated CpG motif, be at least 6 nucleotides in length, and be protected from nuclease degradation by comprising, for example, modified backbone linkage, such as a phosphorothioate linkage.

With respect to linkage modifications, combinations thereof or ribose nucleotides or combinations with deoxynucleotides and complexed or linked to biodegradable carriers; Weiner (*J. Leukocyte Biology*, 68:456-463, 2000) states that the molecular mechanisms of CpG oligonucleotides' immunostimulatory effects are not yet understood (see page 461). While the biological effects of some chemical modifications have been studied for CpG containing oligonucleotides, the incorporation and positioning of chemical modifications relative to the CpG dinucleotide are highly unpredictable (see Agarwal et al, *Molecular Med, Today*, 6:72-81, 2000, especially pp 78-80). Further, the state of the art teaches that the phosphorothioate analogs are the most potent in immune stimulation (see Zhao et al (*Biochemical Pharmacology*, 51:173-182, 1996, page 173 (abstract) and there is no evidence of record that any sequence that is not fully phosphorothiolated provides for immune stimulation in any model.

With regard to an immunostimulating amount of adjuvants, combination of adjuvants, it is noted that the state of the art is unpredictable. Cox et al (*Vaccine*, 1997, 15/3:248-256) teaches "...detail the ways in which an adjuvant can act and to attempt a classification of adjuvants based on their mode of action. The end benefit can be threefold. Firstly, if the pathogenesis of a disease is known, than an adjuvant which can generate a protective immune response can be selected for vaccine formulation. Alternatively, if the pathogenesis and immunology are not well understood, then adjuvants which can generate a range of different immune responses can be rationally selected for study. Thirdly, this knowledge can be used to combine different effects as

desired." (p. 248) The purpose of adjuvant combinations is to combine various adjuvant components to achieve the desired mix of immunological responses. The best known combination is Freund's complete adjuvant (FCA) which combines the immunomodulatory properties of *Mycobacterium tuberculosis* (essentially TDM and MDP) along with the short-term depot effect of w/o emulsions." (p. 253) "Selection of the 'best' adjuvant combination requires some knowledge of the chemical nature of the protective immunogen(s) and some idea of the nature of the immune response which is likely to be protective. however, even where knowledge of both these issues is minimal, rational selection of a small number of basic formulations and additives should permit selection of an effective adjuvant system. It is hoped that this review will help in this rational selection." (p. 253) Cox et al teaches that emulsions can be unstable. Further, Edelman et al (Molecular Biotechnology, 2002, 21:129-148) teaches that "Every adjuvant has a complex and often multi-factorial immunological mechanism, usually poorly understood in vivo. Many determinants of adjuvanticity exist, and each adjuvanted vaccine is unique. Adjuvant safety is critical and can enhance, retard, or stop development of an adjuvanted vaccine. The choice of an adjuvant often depends upon expensive experimental trial and error, upon cost, and upon commercial availability. Extensive regulatory and administrative support is required to conduct clinical trials of adjuvanted vaccines. Finally, comparative adjuvant trials where one antigen is formulated with different adjuvants and administered by a common protocol to animals and humans can accelerate vaccine development." (abstract) (see also, Aucouturier et al Vaccine, 2001, 19:2666-2672 and Wuorimaa et al, J. Infectious Diseases, 2001, 184:1211-1215). Aucouturier et al teaches that there are no universal adjuvants and their action is not yet clear and relies on different mechanisms. Then, they must be adapted according to several criteria, like the target species, the antigens, the type of immune response, the route of inoculation or the duration of immunity. All the above considerations for determining the use of one adjuvant are increased when the selection of a combination of immunostimulating adjuvants as instantly claimed. It would require undue experimentation to practice the claimed invention in view of the unpredictability of the length of the immunostimulatory oligonucleotide, the unmethylated CG and the problem associated with identifying a combination adjuvant.

The factors to be considered in determining whether undue experimentation is required are summarized in re Wands 858 F.2d 731, 8 USPQ2d 1400 (Fed. Cir, 1988). The court in

Wands states: "Enablement is not precluded by the necessity for some experimentation such as routine screening. However, experimentation needed to practice the invention must not be undue experimentation. The key word is 'undue', not 'experimentation.'" (Wands, 8 USPQ2d 1404). Clearly, enablement of a claimed invention cannot be predicated on the basis of quantity of experimentation required to make or use the invention. "Whether undue experimentation is needed is not a single, simple factual determination, but rather is a conclusion reached by weighing many factual considerations." (Wands, 8 USPQ2d 1404). The factors to be considered in determining whether undue experimentation is required include: (1) the quantity of experimentation necessary, (2) the amount or direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims. The nature of the invention, breadth of the claims, unpredictability of the state of the art and state of the prior art have all been addressed above. With regard to the function of methylated form of CpG and the CpG molecules that do not contain a PS backbone, it is impossible to predict that a Th-1 based immune response in vivo utilizing the broad genus of molecules as claimed. The process of identifying a combination adjuvant is unpredictable. The amount of additional experimentation is deemed to be undue because in order to practice the claimed invention with a reasonable expectation of success, one of skill in the art would have to show evidence overcoming art recognized problems that the broadly claimed CpG-containing oligonucleotides would be used in stimulating a Th-1 based immune response in vivo as well as combination adjuvants. The level of the skill in the art is deemed to be high (PhD level). One skill in the art would be compelled to perform undue experimentation in order to practice the claimed invention because of the large number of variables connected with the use of such nucleic acids. For example, the instant application does not give guidance as to the type of administration, the times or frequencies of administration, or the dosages required to obtain desired effects. In view of the combination of facts-- the high degree of unpredictability recognized in the art, particularly the required characteristics of the immunostimulatory oligonucleotide in order to be an effective in vivo immunostimulatory oligonucleotide as well as combination adjuvants, the breadth of the claims as mentioned above, the limited number of working examples and guidance in the specification, the high degree of skill required, it is

concluded that the amount of experimentation required to perform the broadly claimed composition is undue.

6. The attempt to incorporate subject matter into this application by reference to various patents and references, see pages 6 and 27-33, is ineffective because an incorporation by reference must be set forth in the specification and must: (1) Express a clear intent to incorporate by reference by using the root words “incorporat(e)” and “reference” (e.g., “incorporate by reference”). The incorporation by reference will not be effective until correction is made to comply with 37 CFR 1.57(b), (c), or (d). If the incorporated material is relied upon to meet any outstanding objection, rejection, or other requirement imposed by the Office, the correction must be made within any time period set by the Office for responding to the objection, rejection, or other requirement for the incorporation to be effective. Compliance will not be held in abeyance with respect to responding to the objection, rejection, or other requirement for the incorporation to be effective. In no case may the correction be made later than the close of prosecution as defined in 37 CFR 1.114(b), or abandonment of the application, whichever occurs earlier.

Any correction inserting material by amendment that was previously incorporated by reference must be accompanied by a statement that the material being inserted is the material incorporated by reference and the amendment contains no new matter. 37 CFR 1.57(f).

7. No claims are allowed.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to N. M. Minnifield whose telephone number is 571-272-0860. The examiner can normally be reached on M-F (8:00-5:30) Second Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert B. Mondesi can be reached on 571-272-0956. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/N. M. Minnifield/
Primary Examiner, Art Unit 1645
August 16, 2009